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REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner reiterates the previous grounds of rejection. Specifically, the Examiner now rejects claims 1-4 and 17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,083,549 to Cho et al., (hereinafter "Cho"). Additionally, the Examiner also now rejects claims 5-16 under 35 U.S.C. § 103(a) as being unpatentable over Cho in view of U.S. Patent No. 5,084,022 to Claude (hereinafter "Claude").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons set forth below. However, independent claim 1 has been amended to clarify its distinguishing features. Specifically, the endoscope of independent claim 1 has been amended to recite:

an insertion unit having a soft portion;
a small-diameter portion which is included in the soft portion and whose outer diameter is substantially the same over the whole length thereof;
a large-diameter portion which is included in the soft portion and whose outer diameter is larger than the outer diameter of the small-diameter portion being located rearward an endoscope portion separated 70 cm from the distal endoscope end; and
a tapered portion linking the small-diameter portion and the large-diameter portion, the tapered portion being located forward the endoscope portion separated 70 cm from the distal endoscope end.

The amendment to claim 1 is fully supported in the original disclosure. Thus, no new matter has been introduced into the original disclosure by way of the amendment to claim 1.

In order to improve the insertability of an endoscope into a large intestine, a tapered portion is provided in the middle of the insertion portion, a small-diameter portion is provided forward the tapered portion, and a large-diameter portion is provided rearward the

tapered portion, thereby making it easy for any operation at the proximal side to be transmitted to the distal end side.

It seems that the Examiner notes in Cho that the length of the shaft as a whole is 70 cm or less, and is of the view that the tapered portion is therefore forward a portion separated 70 cm from the distal end. However, Applicants respectfully submit that if the shaft is of a length less than 70 cm, it primarily makes no sense to provide a tapered portion. One aspect of the present application relates to an endoscope having an insertion portion of which the insertion length is 70 cm or more that can be inserted into a large intestine, and in the middle thereof that is forward an endoscope portion separated 70 cm from the distal endoscope end is provided a tapered portion, and a large-diameter portion is provided rearward the tapered portion, thereby making it possible to effectively transmit any operation such as twisting at the proximal side of the insertion portion to the distal end side.

In contrast to this, it is noted that Cho relates to a rigid endoscope, which does not include a soft portion through which twisting at the proximal side is transmitted to the distal end side as in the endoscope of the present application.

In addition to the fact that the endoscope of Cho is rigid, it is to be noted that the endoscope of which the whole length is less than 70 cm cannot be inserted into the depth of 70 cm, and still more, the endoscope of Cho has no such soft portion as to extracorporeally extend. Such soft portion as in Cho is primarily not capable of being twisted.

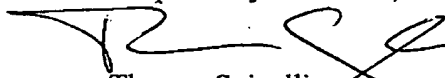
With regard to the rejection of claims 1-4 and 17 under 35 U.S.C. § 102(b), an endoscope having the features discussed above and as recited in independent claims 1 and 17, is nowhere disclosed in Cho. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed

invention, arranged as in the claim,"¹ independent claims 1 and 17 are not anticipated by Cho. Accordingly, independent claims 1 and 17 patentably distinguish over Cho and are allowable. Claims 2-4 being dependent upon claim 1 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-4 and 17 under 35 U.S.C. § 102(b).

With regard to the rejection of claims 5-16 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 5-16 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 5-16 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).